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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT PAPER NUMBER

3711

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/730,586

Applicant(s)

MACKEY, THOMAS J.

Examiner

Stephen L. Blau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,33,35,36,133-139,159 and 161 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8,33,35,36,133-139,159 and 161 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/22/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: In the second occurrence of paragraph (0038) on page 6 line 2 the character "Queen Buildablok" is not the same as what is written in figure 1 as "Queen Boildablok".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-8, 33, 35-36, 133-139, 159 and 161 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically the specification does not disclose how to play the game which is considered essential material. Provisional application 60115162 contains enough disclosure for one skilled in the art to understand the best mode and the method of playing the game. Though this provisional application

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is incorporated by reference since it is neither a U.S. patent, a U.S. patent application publication, or a pending U.S. application, essential information must be included in the specification of this application and not relied upon by incorporating by reference. It would be too much of a burden for the public to acquire a provisional application for an understanding of essential information to enable one skilled in the art to make or use the same. See MPEP 608.01(p) I. The examiner recommends putting the explanation and drawings of how the game is played into this specification as that which was in provisional application 60115162 to remove this rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 33, 35 is rejected under 35 U.S.C. 102(b) as being anticipated by Matsumoto.

Matsumoto discloses a game with a plurality of game-pieces with each game-piece representative of a game character in the form of King or Pawns (Col. 3, Lns. 33-67), each game piece including a miniature (Fig. 1), each game piece having multiple character indicia thereon indicative of character attributes of the character in the form of type of piece (King or Pawn) (Fig. 1) and the number of moves a playing piece may make (Col. 2, Lns. 60-61), a rotating element having a wheel (Fig. 5), a wheel having

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multiple rotating indicia thereon in the form of numbers, one character indicia is associated with the rotating element (Fig. 5), and selectively moving game pieces about a playing surface (Col. 3, Lns. 33-67).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell.

Baca discloses a method of playing a miniature war game (Title) on a playing surface (Fig. 1) with a plurality of game pieces (Figs. 2-12), selected game pieces are representative of individual characters (Figs. 2-9), steps of simulating combat with a mathematical combat resolution in the form of determining the highest and lowest sum of rolled dice incorporating at least one randomizing element in the form of dice (Col. 8, Lns. 10-25), moving at least some of the game pieces representing the characters on the playing surface (Col. 7, Lns. 27-47), each game piece representing multiple distinct character attribute in the form of their purchasing cost, combat value and type (i.e. ruler, king, soldier, etc...) (Col. 5, Lns. 60-67), a combat characteristic having an attack value

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in the form of power value utilized in the mathematical combat resolution (Col. 8, Lns. 10-25, Col. 8, Lns. 1-9), a physical characteristic in the form of value (purchasing value) (Col. 5, Lns. 60-67).

Baca lacks the multiple independent visible indicia indicative of distinct character attributes, indicia being numbers, and indicia representing both value of the attribute and associated attribute. Powell discloses the multiple independent visible indicia in the form of numbers indicative of distinct character attributes and values of the attributes in the form of mobility and strength (Col. 4, Lns. 26-51, Figs. 8-14). In view of the patent of Powell it would have been obvious to modify the game of Baca to have multiple independent visible indicia in the form of numbers indicative of distinct character attributes and value of the attributes in order to make it easier for a player to remember the character attributes for each of the game pieces. In view of the patent of Powell it would have been obvious to modify the game of Baca to have additional attributes as movement value with an independent visible indicia in the form of a number indicative of distinct character attributes in order to make a game more complex.

8. Claims 4-5, 33, and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell as applied to claims 1-3 above, and further in view of Matsumoto.

Baca lacks an indicia for physical characteristic of character type and a game piece having a rotating wheel integral where the wheel indicates indicia in the form of a number viewed through an aperture indicative of an character attribute.

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Matsumoto discloses a miniature war game with indicia for physical characteristic of character type in the form of King and Pawns (Col. 3, Lns. 33-67, Fig. 1). In view of the patent of Matsumoto it would have been obvious to modify the game of Baca to have an indicia for physical characteristic of character type in order to reduce cost of manufacturing the game by not having to actually manufacture the form of a character type.

Matsumoto discloses a game piece having a rotating wheel integral where the wheel indicates indicia indicative of an character attribute in the form of how many areas a piece may move (Col. 3, Lns. 33-50). In view of the patent of Matsumoto it would have been obvious to modify the game of Baca to have a game piece having a rotating wheel integral where the wheel indicates indicia in the form of a number viewed through an aperture indicative of an character attribute in order to be able to vary the characteristics for a game piece.

9. Claims 6-8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell and Matsumoto as applied to claims 4-5 above, and further in view of Jorma.

Baca lacks a game with a step of measuring movement with a measurement mechanism distinct from the playing surface.

Jorma discloses a war game with not squares but a step of measuring movement with a measurement mechanism distinct from the playing surface (Fig. 2) in order to have a boardless game (Col. 1, Lns. 8-14). In view of the reference of Jorma it would

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have been obvious to modify the game of Baca to have with a step of measuring movement with a measurement mechanism distinct from the playing surface in order to have a boardless game.

10. Claims 133-135 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell and Jorma.

Baca discloses positioning simulated structures on the playing surface in the form of a catapult and siege tower (Figs. 10-11).

See paragraphs above for elements of structure previously rejected by Baca in view of Powell and Jorma.

11. Claim 136 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell and Jorma as applied to claims 133-135 above, and further in view of Matsumoto.

See paragraphs above for elements of structure previously rejected by Baca in view of Matsumoto.

12. Claims 137-139 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell, Jorma and Matsumoto as applied to claim 136 above, and further in view of Rhea.

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Baca lacks providing a plurality of structural units for forming a variety of simulated structures including a castle positioned on the playing surface and building and placing selected simulated structures on a playing surface.

Rhea discloses a plurality of structural units for forming a variety of simulated structures including a castle positioned on the playing surface (Figs. 1-4) and building and placing selected simulated structures on a playing surface in the form of building a wall by placing structures on the playing surface (Fig. 1). In view of the patent of Rhea it would have been obvious to modify the game of Baca to provide a plurality of structural units for forming a variety of simulated structures including a castle positioned on the playing surface and building and placing selected simulated structures on a playing surface in order to add more atmosphere to the game.

13. Claims 159 and 161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baca in view of Powell and Matsumoto as applied to claims 4-5, 33, and 35-36 above, and further in view of Rhea.

See paragraphs above for elements of structure previously rejected by Baca in view of Rhea.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the

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examiner should be directed to Steve Blau whose telephone number is (703) 308-2712.

The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (703) 308-1513. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0858. (TC 3700 Official Fax 703-872-9306)

slb/ 17 May 2004


STEPHEN BLAU
PRIMARY EXAMINER